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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		JPD-4398-286
Application Number		Filed
10/781,949		February 20, 2004
First Named Inventor		Ging
Art Unit	Examiner	
3772	Nihir B.Patel	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
I am the		/John P. Darling/
<input type="checkbox"/> Applicant/Inventor		Signature
<input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)		John P. Darling
<input checked="" type="checkbox"/> Attorney or agent of record		Typed or printed name
44,482		703-816-4887
(Reg. No.)		Requester's telephone number
<input type="checkbox"/> Attorney or agent acting under 37CFR 1.34.		July 7, 2008
Registration number if acting under 37 C.F.R. § 1.34 _____		Date
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p>		
<input checked="" type="checkbox"/> *Total of 1 form/s are submitted.		

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STATEMENT OF ARGUMENTS

The following listing of clear errors is responsive to the Office Action dated March 4, 2008 and the Advisory Action dated June 30, 2008, each of which errors should independently result in the withdrawal of the rejections.

As was clearly noted on page 9, lines 5-10, of the response filed June 4, 2008, claims 8, 9, 20 and 22 were rewritten in independent form, including all the limitations of the base claim and any intervening claims. In addition, claims 25-27 were cancelled without prejudice or disclaimer. Despite the clear lack of any new issues presented by the June 4, 2008 response, the Advisory Action states that for purposes of appeal the June 4, 2008 amendments will not be entered. It is respectfully submitted that the examiner's refusal to enter the June 4, 2008 amendments for purposes of appeal is clearly improper.

37 C.F.R. §1.116(b)(2) states:

After a final rejection or other final action (§1.113) in an application or in an *ex parte* reexamination filed under §1.510, or an action closing prosecution (§1.949) in an inter partes reexamination filed under §1.913, but before or on the same date of filing an appeal (§41.31 or §41.61 of this title): An amendment presenting rejected claims in better form for consideration on appeal may be admitted.

As the amendments to claims 8, 9, 20 and 22 merely rewrote the claims in independent form, cancelled base claims 7 and 19, and cancelled dependent claims 25-27, the amendments clearly reduced the issues for appeal by obviating the rejection of claims 7, 19 and 25-27 under 35 U.S.C. §102(e) over Palkon et al. (U.S. Patent 7,007,696). The amendments thus left only one issue for appeal, the rejection of claims 8-12 and 20-24 under 35 U.S.C. §103(a) over Palkon et al. Clearly the amendments filed June 4, 2008 should be entered for purposes of appeal.

The rejection of claims 8-12 and 20-24 under 35 U.S.C. § 103(a) over Palkon et al. fails to establish a *prima facie* case of obviousness because the examiner has failed to correctly

determine the scope and content of the prior art, and thus the differences between the prior art and the claims, and has improperly relied on inapplicable case law rationale in an attempt to cure the deficiencies of Palkon et al.

With respect to the features recited in claims 8, 9, 20 and 22, and dependent claims 10-12, 21, and 23, the March 4, 2008 Office Action acknowledges that Palkon et al. do not disclose or suggest these features, but concludes that the claims would have been obvious in view of Palkon et al. "since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art." The Office Action cites In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). See paragraphs 12-15, 17 and 18 of the March 4, 2008 Office Action.

Applicants have repeatedly traversed the examiner's reliance on the rationale used by the Court in In re Aller as the facts of In re Aller are not sufficiently similar to the instant application to permit the examiner to rely solely on the rationale used by the court. See, for example, page 10 of the June 4, 2008 response; page 11 of the February 20, 2008 response; and pages 13-15 of the July 9, 2007 response.

M.P.E.P. §2144.04 states:

if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

The facts of In re Aller are discussed in M.P.E.P. §2144.05(II).A. The case of In re Aller involved a claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70%. The claimed process was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.

In response to Applicants' arguments, the examiner replied, on page 2, paragraph number 2, of the March 4, 2008 Office Action, "The dimensions described in claims 8-12 and 20-24

depend on the size of babes, kids and adult. Not all babes, kids or adults have the same size. Therefore, it would have been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or workable ranges involves only routine skill in the art since the size of the device depends on the size of the baby, kid or an adult.”

Firstly, with respect to the dimensions recited in claims 8-12 and 20-24, Palkon et al. do not disclose or suggest the general conditions of any of these claims.

In response to Applicants’ arguments, the examiner states, in the Advisory Action, “The phrase optimum or workable ranges basically implies to any type of measurement units whether its temperature or a fitting measurement.”

It is respectfully submitted that the court’s use of the term “optimum or workable ranges” in the decision of In re Aller does not imply “any type of measurement units” as concluded by the examiner. As was noted by Applicants’ in their arguments regarding In re Aller, the facts of that case involved differences in the temperature and acid concentration. In other words, the prior art at issue in In re Aller disclosed some value for temperature and acid concentration that differed from the claimed temperature and acid concentration.

In contrast, Palkon et al. do not disclose or suggest any value for the width of the membrane orifice, the width of the rim orifice, the membrane height(s), and/or the rim height(s), for example as recited in claim 8. Palkon et al. also fail to disclose values for features recited in claims 9-12 and 20-24. Therefore, the facts of In re Aller are not sufficiently similar to the instant application to permit the examiner to rely on the court’s rationale.

Secondly, As Applicants noted on pages 10-11 of the June 4, 2008 response and pages 13-15 of the July 9, 2007 response, M.P.E.P. §2144.05(II).B. discusses the case of In re Antoine, 559 F2d 618, 195 USPQ 6 (CCPA 1977). As the court found in the case of In re Antoine, a particular parameter must be recognized by the prior art as a result-effective variable, i.e., a

variable which achieves a recognized result, before the determination of the optimum or workable ranges of the variable might be characterized as routine experimentation.

As was discussed on pages 14-15 of the response filed July 9, 2007, Palkon et al. do not disclose or suggest that any of the dimensions recited in claims 8-12 and 20-24 are result-effective variables. Palkon et al. disclose in column 4, lines 44-47, that the variable thicknesses in the membranes 46, 47 and 48 are a significant feature of the invention and provide a significant improvement in the comfort of the cushion 30. Palkon et al. also disclose in column 5, lines 24-29, that the length of the sidewall portion 45A provides an improved angle of contact when the cushion 30A is worn by the user. Therefore, the only result-effective variables recognized by Palkon et al. are the variable thicknesses of the membranes and the length of the sidewall portions of the cushion. Palkon et al. do not recognize, for example, that a width of the membrane orifice or the membrane height is a result-effective variable. Accordingly, it would not have been obvious to one of ordinary skill in the art to modify Palkon et al. to arrive at the dimensions recited in claim 8. As another example, claim 9 recites the dimensions of the rim aperture and an effective height of the rim, and an effective ridge depth of the rim. Palkon et al. do not recognize that any of these features are a result-effective variable. Therefore, claim 9 would not have been obvious to one of ordinary skill in the art.

The examiner has not provided any response to Applicants' arguments that Palkon et al. fail to recognize any of the claimed features as result effective variables.

Thirdly, as previously noted by Applicants, paragraph [0014] of the instant application, for example, discloses that WO 2001/32250 discussed the problems of scaling down an adult size mask to approximate the face and nose of an infant. WO 2001/32250 discloses at least three problems in the design of masks. However, WO 2001/322250 also fails to recognize any of the features recited in claims 8-12 and 20-24 as result effective variables. The dimensions recited in claims 8, 9, 20 and 24 are therefore not the result of routine experimentation and optimization.